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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/775,528

02/01/2001

Nicholas Donofrio JR.

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(DONO-101.2)

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21832

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07/09/2003

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,528

Applicant(s)

DONOFRIO, NICHOLAS

Examiner

Naschica S Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/6/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13-32 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) 2, 5-10, 18 and 21-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 13-17, 19, 20 and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is the fourth Office Action for serial number 09/775,528, Display Device for Sports Memorabilia, filed on February 1, 2001. Claims 1-10, 13-32, and 35-38 are pending. Claims 2, 5-10, 18, and 21-32 were withdrawn from further consideration.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/6/03 has been entered.

Specification

The disclosure is objected to because of the following informalities: on page 1, line 18, "preferably" should be --preferable--. Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities: on line 4, "Wherein" should be --wherein--; on line 5, delete "." after "metal"; on line 7; "distal ends. This" should be --distal ends; this"; on line 6, "flat or" should be deleted since the embodiment

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of the invention (Fig. 8) which reads on this limitation was non-elected for prosecution in the present application. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3, 4, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites the distal ends having a flat or rounded "grommet". The specification of the present invention does not disclose the *retainers* as "grommets". Additionally, claim 1 further recites the plastic being "high grade"; however this limitation is not supported by the originally filed specification. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). If applicant intends to claim the design being made of plastic or metal it is suggested that the claim language recite "... design is made of non-flexible high grade plastic or metal".

Double Patenting

Applicant is advised that should claims 14-16 be found allowable, claims 36-38 will be objected to under 37 CFR 1.75 as being a *substantial duplicate* thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,727,325 to Jurinic. Regarding claims 1, 3, and 4, Jurinic discloses a display device comprising: a base (16); a rigid U-shaped arm assembly (12 defined by members 18, 58, 20) extending from the base and including first (18) and second (20) arms having spaced apart distal ends; and first and second rounded grommets/flexible cups (32,34) attached to the first and second arms such that the grommets/cups face

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each other, wherein the grommets/flexible cups can be pressed against the arms to receive memorabilia therebetween and then released to hold the memorabilia. Jurinic does not teach the U-shaped arm assembly being formed of high-grade plastic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the U-shaped design to be formed of high-grade plastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jurinic in view of U.S. Patent 5,560,579 to Woodside. With regards to claim 13, Jurinic discloses the display device as applied above, but does not disclose the base adapted to be hung on a wall. Woodside discloses a display device (Fig. 2) having a base (18) including apertures (29). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the base (16) by including apertures because one would have been motivated to permit the device to be securely fastened to its support surface as taught by Woodside (col. 3, lines 58-61).

Claims 14, 17, 19, 20, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Des. 365,948 to Borden in view of U.S. Patent 2,727,325 to Jurinic. Regarding claims 14, 17, 19, 20 and 36, Borden discloses a display device (see attached marked copy of Fig. 3) comprising a base (1), first and second arms (2) extending from the base, first and second retainers (3) attached respectively to the first and second arms, and sports memorabilia (4) supported between the first and second

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retainers (3). Borden does not teach one of the arms or one of the retainers being flexible. Jurinic discloses the display as applied to claims 1, 3, and 4 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the display device of Jurinic for the display device of Borden because one would have been motivated to permit rotation of the article to various positions while viewing as taught by Jurinic (col. 1, lines 19-21).

Claims 15, 35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borden in view of Jurinic and further in view of U.S. Patent 5,560,579 to Woodside. With regards to claims 15, 35, and 37, Borden in view of Jurinic discloses the display device as applied above, but does not disclose the base adapted to be hung on a wall. Woodside discloses a display device (Fig. 2) having a base (18) including apertures (29) for mounting to a wall. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the base (16) by including apertures because one would have been motivated to permit the device to be mounted on vertical surfaces as well as horizontal surfaces as taught by Woodside (col. 3, lines 58-61).

Claims 16 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borden in view of Jurinic and further in view of U.S. Patent 339,072 to Nies. With regards to claims 16 and 38, Borden in view of Jurinic does not disclose the arm assembly having a third arm. Nies discloses a clamp device (figure 1 generally) having a third arm (M) located between the first and second arms. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have

modified the arm assembly by including a third arm between the first and second arms (generally located at 14) because one would have been motivated to provide an additional arm to increase the attaching engagement of the arm assembly with the structure being clamped and further since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

Response to Arguments

Applicant's arguments filed 5/6/03 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the U-shaped frame being non-mechanically adjustable; the present invention not including any screws, cranks or clamping down devices) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicant's argument of Downs and Scott, examiner respectfully reminds applicant that neither Downs nor Scott has not been relied upon as a basis for the rejections above. Regarding applicant's argument of Woodside, Woodside has only been relied upon to teach apertures in the base of the holder.

In response to applicant's arguments against the references individually (in particular, applicant's arguments regarding Borden), one cannot show nonobviousness

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by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

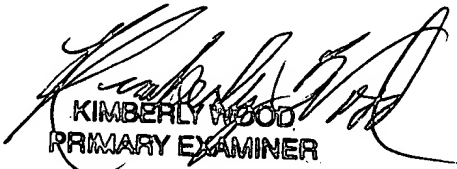
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 6,581,887 to Lapidez discloses a mounting assembly.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine telephone number for the Technology Center is (703) 872-9326 (formal amendments) or (703) 872-9327 (After Final amendments).

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 872-9325.


Naschica S. Morrison
Patent Examiner
Art Unit 3632
6/25/03


KIMBERLY WOOD
PRIMARY EXAMINER